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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/963,981      | 09/26/2001  | Gero Baese           | 112740-300          | 3320             |

29177 7590 06/05/2007  
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| EXAMINER |
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VAN HANDEL, MICHAEL P

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| ART UNIT | PAPER NUMBER |
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2623

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| MAIL DATE | DELIVERY MODE |
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06/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/963,981

Applicant(s)

BAESE ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/2007 has been entered.

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 3/12/2007. Claims 1-14 are pending. Claims 1-3, 7-11 are amended. The rejections of claims 1, 3-14 under 35 U.S.C. 112, first paragraph, are hereby withdrawn in light of the amendments.

### ***Response to Arguments***

1. Applicant's arguments regarding claims 1, 8, 10, and 11, filed 3/12/2007, have been fully considered, but they are not persuasive.

Regarding claims 1, 10, and 11, the applicant argues that the teletext information of Sharma is added as additional information to a television signal, not as information to a television program being concurrently broadcast. The applicant further argues that there is nothing in Sharma that discloses that the teletext messages represent content of a television program being concurrently broadcast. The examiner respectfully disagrees. Sharma discloses a

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communication system and method for communicating teletext information to mobile stations.

A wireless access protocol (WAP) server is coupled to a television station and receives a signal, which includes teletext information from the station. The WAP server includes a teletext decoder, which decodes the teletext information in the transmitted signal. The decoded information is stored in memory using a server controller. The controller receives information requests from a network interface coupled to the mobile stations. The controller accesses the teletext information stored in memory and transmits the information to the mobile station through the network interface (see Abstract).

Sharma discloses that a television station 100 encodes informational messages on its television data signal as teletext. The encoded messages may include news and current events, real-time financial data, travel and weather information, entertainment and dining information, retail advertising, and emergency/disaster information (col. 3, l. 65-67 & col. 4, l. 1-4). Sharma further discloses that broadcast programs can be encoded with teletext messages containing closed captioning to assist hearing impaired audiences (col. 3, l. 57-59). The examiner notes that the closed captioning data assisting hearing-impaired audiences is related to a current broadcast television program. As such, the examiner maintains that Sharma meets the limitations of “a method of transmitting data which represents contents of a related television program that is being concurrently broadcast comprising the steps of radio transmitting the data which represents textual contents of the related television program from a transmitter to a mobile terminal,” as currently claimed.

Regarding claim 8, the applicant states that the applicants have amended claim 8 as suggested by the examiner. The examiner respectfully disagrees. In the Office Action mailed

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12/11/2006, the examiner recommended that the phrase "the a user" be changed to "a user." The phrase "the a user" lacks antecedent basis. The examiner notes that the claim language has not been changed as recommended (see Claim Objections below).

### ***Claim Objections***

1. Claim 8 is objected to because of the following informalities:

Referring to claim 8, the examiner recommends that the phrase "the a user" be changed to "a user." The examiner addresses the claim in the Office Action below as though the recommended changes have been made.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 2, the amended claim recites a "step of storing at least one video recording of the television program based on the reception of the radio transmitted data." The applicant's specification recites that "the transmitted data may be stored in a memory device 12

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prior to transmission” and that “the television program for which the data relates can be stored in a memory device 11 (p. 5, l. 7-9);” however, the examiner fails to find any mention of how the recording of a television program is based on the reception of the radio transmitted data.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1, 5-7, 9, 11-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Sharma.

Referring to claims **1** and **9**, Sharma discloses a method of transmitting data which represents contents of a related television program that is being concurrently broadcast comprising the steps of radio transmitting the data which represents textual contents of the related television program from a transmitter to a mobile terminal (the examiner notes that teletext messages are decoded from television signals and transmitted to mobile stations 112. Telephonic communication is effectuated between the mobile station and the WAP server 102. A user can refresh a teletext page containing the latest score of a soccer match, thereby transmitting data which represents contents of a related television program that is being concurrently broadcast, as claimed)(col. 3, l. 64-67; col. 4, l. 1-36, 48-54; col. 5, l. 14-53; col. 7, l. 26-28; & Fig. 1).

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Referring to claim 5, Sharma discloses a method as claimed in claim 1, further comprising the step of storing pre-selected television program information in memory (col. 5, l. 63-67 & col. 6, l. 1-5), and wherein the transmitting step further comprises transmitting the stored pre-selected television program information (col. 4, l. 17-36).

Referring to claim 6, Sharma discloses a method as claimed in claim 5, wherein the transmitting step further comprises transmitting the stored pre-selected television program information by one of automatically, according to a predetermined schedule, on request, and combinations thereof (col. 4, l. 17-36; col. 5, l. 20-23; & col. 7, l. 24-35).

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claim 7, Sharma discloses a method as claimed in claim 1, further comprising the step of matching a form of the data to display options of the mobile terminal (col. 5, l. 30-53; col. 6, l. 9-16).

Referring to claim 11, Sharma discloses an apparatus for transmitting data, which at least partially represents contents of a television program to a mobile terminal, comprising:

- a device having a television program (col. 5, l. 63);
- a device having data, which at least partially represents textual contents of the television program (col. 5, l. 63-67 & col. 6, l. 1-5); and
- a transmitter connected to the device having the television program and the device having data, which at least represents contents of the television program, the transmitter transmitting the data via a mobile radio network to the mobile terminal

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concurrently with a broadcast of the television program (col. 4, l. 17-36, 48-54 & col. 6, l. 6-23).

Referring to claim **12**, Sharma discloses an apparatus according to claim **11**, wherein the device having a television program further comprises one of a device having a live television program (the examiner notes that it is inherent for the WAP server to have a live television program in order to provide the latest score of a soccer match)(col. 7, l. 23-28), a memory, which stores a recorded television program, and combinations thereof.

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **13** and **14**, Sharma discloses an apparatus according to claims **11** and **12**, respectively, wherein the device having data, which at least partially represents contents of the television program, further comprises one of a device having on-line generated data (col. 7, l. 24-35), a memory, which stores the data (col. 5, l. 63-67 & col. 6, l. 1-5), and combinations thereof.

NOTE: The USPTO considers the applicant's "one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

3. Claim **10** is rejected under 35 U.S.C. 102(e) as being anticipated by Marshall et al.

Referring to claim **10**, Marshall et al. discloses an apparatus for transmitting data, which at least partially represents contents of a television program to a mobile terminal, comprising:



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- a television program memory device capable of storing the television program (the examiner notes that the transaction processing and subscription management system 24 can record racing videos)(col. 13, l. 32-57);
- a data memory device having the data, which at least partially represents textual contents of the television program (col. 7, l. 2-5; col. 14, l. 51-67; & col. 15, l. 1-10); and
- a transmitter device connected to the television program memory device and the data memory device, the transmitter device transmitting the data via a mobile radio network to the mobile terminal concurrently with broadcast of the television program (col. 13, l. 35-36; col. 14, l. 51-67; & col. 15, l. 1-10).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Wegener et al.

Referring to claims 2 and 4, Sharma discloses the method as claimed in claim 1. Sharma does not disclose a step of storing at least one video recording of the television program based on the reception of the radio transmitted data or transmitting video data which represents contents of the television program. Wegener et al. discloses transmitting video content to a cellular

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telephone and storing the video content in the cellular telephone's memory (col. 3, l. 46-48; col. 5, l. 14-60; & Fig. 1). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Sharma to include transmitting and storing video content on a cellular phone, such as that taught by Wegener et al. in order to quickly provide a user with additional multimedia content.

3. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Wegener et al. and further in view of Sladek et al.

Referring to claim 3, the combination of Sharma and Wegener et al. teaches the method as claimed in claim 2. The combination of Sharma and Wegener et al. does not teach that the transmitting step further comprises transmitting additional data related to the television program via short message service (SMS). Sladek et al. discloses sending an SMS message indicating a television station that is being watched to a cellular phone (col. 4, l. 4-6; col. 5, l. 46-50; & col. 16, l. 14-17). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Sharma and Wegener et al. to include sending an SMS message indicating a television station that is being watched to the cellular telephone, such as that taught by Sladek et al. in order to provide a user with useful informational updates.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharma in view of Youngs et al.

Referring to claim 8, Sharma discloses a method as claimed in claim 1. Sharma further discloses a mobile switching center (MSC)(col. 4, l. 42-54). Sharma does not disclose a step of

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automatically billing costs for the transmission via a telephone bill for the user of the mobile telephone. Youngs et al. discloses a Mobile Switching Center (MSC) 22, which compiles mobile billing information (col. 2, l. 27-30). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the MSC of Sharma to compile mobile billing information, such as that taught by Youngs et al. in order to appropriately compensate network and content providers for the usage of their products/services.

### *Conclusion*

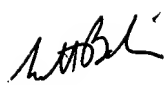
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MVH

  
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PRIMARY PATENT EXAMINER